

REMARKS

Claim Rejections – 35 USC § 103

3. Claims 1-4, 8-21 and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall US Patent 5,774,878 in view of SmartMoney.com hereinafter known as SmartMoney in further view of Datek Online supported by an article from PRNewsWire "Streamer Free Real-Time Stock Quote Service Registers 12,000 Users" hereinafter known as Datek and Internet Sample Business Plan by IntelliChild.com hereinafter known as IntelliChild.

In the office action, the Examiner has rejected claims 1-4, 8-21 and 25-34 under 35 U.S.C. § 103(a) as being unpatentable over Marshall (5,777,878) in view of SmartMoney in further view of Datek and IntelliChild. The Examiner's rejection of independent claims 1 and 18 (and all claims depending therefrom) is respectfully traversed.

As amended, Claim 1 recites a method for displaying the status of a financial indicator using a geographic orientation, said financial indicator representing financial activity in a particular geographic region, said financial indicator including a plurality of sectors and each of said sectors including a plurality of financial instruments, the method comprising the steps of: displaying a map, said map including said geographic region; and simultaneously displaying on said geographic region of said map a visual indicator that represents the status of said financial indicator, each of said sectors and each of said financial instruments; wherein each of said plurality of sectors has a size and a weighting in the financial indicator, wherein said size of each of said plurality of sectors is proportional to said weighting of each of said plurality of sectors, respectively.

As amended, Claim 18 recites a system for displaying the status of a financial indicator using a geographic orientation, said financial indicator representing financial activity in a particular geographic region, said financial indicator including a plurality of sectors and each of said sectors including a plurality of financial instruments, the system comprising: a data source including the status of said financial indicator; and a mapping engine, said mapping engine having a map including said geographic region, said mapping engine receiving the status of said financial indicator from said data source, said mapping engine outputting a signal for simultaneously displaying on said geographic region of said map a visual indicator that

represents the status of said financial indicator, each of said sectors and each of said financial instruments; wherein each of said plurality of sectors has a size and a weighting in the financial indicator, wherein said size of each of said plurality of sectors is proportional to said weighting of each of said plurality of sectors, respectively.

Even if Marshall, SmartMoney, Datek and InteliChild included a description of each of the claimed limitations, which they clearly do not, Applicant respectfully submits that there is no motivation for one of ordinary skill in the art to combine the cited references. The Examiner has not demonstrated in the Office Action dated May 19, 2004 a source for a motivation to combine the references. See In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) ("There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts.").

The grounds offered by the Examiner for combining the cited Marshall, SmartMoney and Datek references is "it would have been obvious to one of ordinary skill in the art at the time the invention was made to display status of financial instruments to help the user decide what course of direction to take in response to market movement." (Office Action of May 19, 2004, p. 4-5.) The Examiner has attempted to support this statement by a cursory description of some of the features of each of the cited references. Notwithstanding, however, the Examiner's description of those references, the Examiner's statement concerning "one with ordinary skill in the art" simply is not substantiated and does not meet the Examiner's obligation to succinctly establish a *prima facie* case of obviousness. Moreover, the Examiner has not provided sufficient support for his statement because he has not shown evidentiary support for his assertion that "it is known to one of ordinary skill in the art at the time the invention was made that Streamer [Datek] uses color indicators and uses color to inform users change in direction of prices for financial instrument, or uses line graph to display the status of the stock with the direction of graph going up or down to inform users change in direction of prices for financial instrument. (Office Action of May 19, 2004, p. 4.)

The undersigned respectfully submits that a conclusion of the “obviousness” should be supported by some objective evidence. However, the Examiner has provided no objective support for his conclusion. The undersigned submits that this appears to be a case in which the Examiner’s conclusion of “obviousness” is merely based on an application of hindsight reasoning gained by the Examiner’s review of the present application. Such hindsight reasoning is impermissible. As the MPEP notes:

The tendency to resort to “hindsight” based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP 2142. Furthermore, MPEP 2143 states:

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP 2143.

However, here again, the Examiner has not cited where in the prior art there is a teaching or suggestion to make the claimed combination. It follows then that if the teaching to make the combination is not found in the prior art, then such a teaching may have been impermissibly derived from applicant’s disclosure. The undersigned respectfully requests that the Examiner either withdraw his rejection of the claims or provide some objective evidence of a teaching found in the prior art to make the combination made by the Examiner.

Thus, the Examiner’s conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made is unsupported by the cited Marshall, SmartMoney and Datek references.

Moreover, whether or not this is the case, the Examiner has acknowledged that “Marshall in view of SmartMoney does not teach each of said plurality of sectors has a size and weighting in the financial indicator, wherein said size of said plurality of sectors is proportional to said weighting of each of said plurality of sectors, respectively” (Office Action of May 19, 2004, p. 5.) The Examiner thus must rely upon InteliChild for his conclusion that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marshall

in view SmartMoney as taught by InteliChild to inform the user that the effect of one financial commodity to the whole portfolio.” (Id.)

The Examiner’s rejection in light of InteliChild is respectfully traversed for at least the reason that InteliChild is not a valid prior art reference. With regard to the date of the InteliChild reference, although the reference bears a date of January, 2000 and a copyright notice dated 2000, there is no showing that this reference was in fact publicly available as of that date. The InteliChild reference is a publication currently available on the Internet. However, the Examiner has not provided any indication that the reference was available via the Internet or in printed form at any specific prior date. Regardless of the fact that the Examiner may have been able to obtain the reference currently, there has been no showing by the Examiner that this “Internet Sample Business Plan” meets the requirements of § 102 that the reference be available to the public.

“A reference is proven to be a ‘printed publication’ ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.’ *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981)” MPEP § 2128. The Examiner has made no showing that InteliChild was disseminated or otherwise made available such that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, could have located it.

The InteliChild Internet Sample Business Plan is a sample business plan taken by the publisher of a business planning software application for use as a sample business plan. As Palo Alto Software states on the first page of the InteliChild reference, “Names, numbers, and substantial portions of text may have been omitted to preserve confidential information.” (InteliChild, p. 1.) Thus, it is apparent that whenever the actual InteliChild business plan was created, it was only later adapted by Palo Alto Software for use in modified, redacted form as a sample business plan. While the reference states a date of January, 2000, there is no indication that this was a date on which the reference was available to the public. In fact, the second page of the reference is a “Confidentiality Agreement,” which states that the reference is

“confidential” and is not to be disclosed by the recipient, suggesting that, to the extent the reference was, in fact, printed as of such date, it was held as confidential and was not then publicly available. There is simply not “a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” MPEP § 2128.

“Prior art disclosures on the Internet ... are considered to be publicly available as of the date the item was publicly posted. If the item does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art.” MPEP § 2128. Here, the date on the first page of the Internet sample business plan reference cannot be relied upon as a valid or actual publication date (or retrieval date), as the document includes significant sample, fictitious and bogus information. See, e.g., IntelliChild, p. 10 (“This is sample text only. This is sample text only. This is sample text only. ...”). As such, the IntelliChild cannot be relied upon as a prior art reference.

The IntelliChild reference is unlike a newspaper, magazine or other reference having a notoriously well-known and reliable publishing schedule where based upon a series of prior distributions, one may come to rely on the publication date as indicative of an actual date of availability to the public. Even were this minimal standard sufficient to show public availability, this reference does not meet that standard, as in this case there is nothing to tie any date on or in the document to the actual date of public availability.

Further, even if the IntelliChild was a valid prior art reference, one of ordinary skill in the art of the claimed invention would have no motivation to combine. IntelliChild relates to either 1) information concerning business planning and business plan software; or 2) a business plan for a website business addressing children between the ages of 8 and 12 years. In either case, those skilled in the art of the claimed invention, a method and system for graphically presenting financial information, would have no interest in nor motivation to combine with the IntelliChild reference.

Moreover, a valid prior art reference must disclose how to make and use the invention to one of ordinary skill in the art. The Examiner asserts that InteliChild teaches the claim limitation "each of said plurality of sectors has a size and a weighting in the financial indicator, wherein said size of each of said plurality of sectors is proportional to said weighting of each of said plurality of sectors, respectively." In support of his assertion, the Examiner merely cites to page 8 of InteliChild. Page 8 of InteliChild includes only 1) a pie chart titled "Market Analysis (Pie)," 2) a table titled "Market Analysis" and 3) text under a heading "Website Demographics." The Examiner has not demonstrated with this citation that InteliChild in any way includes information that teaches or discloses how to make and use the invention of the cited claim limitation.

The Examiner has not demonstrated that InteliChild is a valid reference, that one of skill in the art would have been interested in it or motivated to combine, nor that it teaches anything relevant to the claimed invention.

For at least the foregoing reasons, the Examiner's rejection of claim 1 and 18 under 35 U.S.C. § 103 is improper. For the same reasons that InteliChild is not a valid prior art reference and that Marshall, SmartMoney and Datek, with or without InteliChild, either alone or in combination, fail to disclose the limitations of independent claims 1 and 18, they lack the limitations of dependent claims 2-4, 8-17, 19-21 and 25-34.

As such, Applicants respectfully submit that notice to the effect that claims 1-4, 8-21 and 25-34 are in condition for immediate allowance is respectfully requested.

In the present application, applicants submit that the Examiner has failed to make out a *prima facie* case of obviousness; accordingly, the Examiner's rejection under § 103 is not supported and it is respectfully requested that it be withdrawn.

Application No. 09/678,902

Reply to the Office Action of May 19, 2004

CONCLUSION

For the foregoing reasons, allowance of this application, as amended, is courteously urged.

Claims 1-4, 8-21 and 25-34 are now pending and believed to be in condition for allowance. Applicants respectfully requests that all pending claims be allowed.

Early and favorable action is respectfully requested.

Please apply any credits or excess charges to our deposit account number 50-0521.

Respectfully submitted,

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